

REMARKS/ARGUMENTS

Applicants have received and carefully reviewed the Office Action mailed April 22, 2010. Currently, claims 5-31, 52, 54-72, and 74-95 are pending, with claims 5-31 previously withdrawn from consideration. Claims 52, 54-72, and 74-95 have been rejected. Applicants respectfully traverse all adverse assertions and rejections presented in the Office Action. With this amendment, claims 52, 58, 61, 72, 75, 78, and 81 have been amended and claims 57 and 77 have been canceled. No new material has been added. Favorable consideration of the above amendments and the following remarks is respectfully requested.

Claim Amendments

Independent claims 52 and 72 have been amended to include additional elements to further distinguish from the cited references. The amendments are supported, for example, by Figures 1-3 and the accompanying portions of the specification.

Claims 57 and 77 have been canceled.

Claims 58, 61, 78, and 81 have been amended to correct dependency following the cancellation of claims 57 and 77.

Claim 75 has been amended to correct a typographical error.

Claim Rejections – 35 USC § 102

Claims 52, 54, 55, 57-63, 70-72, 74, 75, 77-83, and 90-95 were rejected under 35 U.S.C. §102(e) as anticipated by Stanford et al. (U.S. Patent No. 6,840,950). Applicants respectfully point out that the reference number cited in section 3 of the Office Action appears to be incorrect, as U.S. 6,850,950 refers to Clarke et al. With this amendment, claims 57 and 77 have been canceled, rendering their rejection moot. After careful review, Applicants respectfully traverse the rejection of claims 52, 54, 55, 58-63, 70-72, 74, 75, 78-83, and 90-95, particularly in view of the current amendments.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)... “The identical invention must be shown in as complete detail as is contained in

the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (MPEP 2131).

Stanford et al. do not appear to disclose or suggest an expandable frame disposed within and supporting the first tapered portion and the second tapered portion of the filter. Instead, Stanford et al. appear to disclose resilient arms 41, 42, and 43, as shown in Figure 2, attached to a proximal end of stent 40. Arms 41, 42, and 43 do not appear to be disposed within the asserted first and second tapered portions. Additionally, Figure 15, cited alternately in the Office Action, is disclosed by Stanford et al. as "a plastic tube 261 wherein a plurality of laser cut perforations 295 is formed". Nowhere do Stanford et al. appear to disclose an expandable frame disposed within and supporting plastic tube 261.

For at least the reasons discussed above, Stanford et al. do not appear to disclose each and every element set forth in the claims in as complete detail as is found in independent claims 52 and 72. Therefore, Stanford et al. cannot anticipate the claims. Since claims 54, 55, 58-63, 70-71, 74, 75, 78-83, and 90-95 depend from claims 52 and 72 and add additional limitations thereto, Applicants believe these claims are also not anticipated by Stanford et al. Therefore, Applicants respectfully request that the rejection be withdrawn.

Claim Rejections – 35 USC § 103

Claims 56 and 76 were rejected under 35 U.S.C. §103(a) as being unpatentable over Stanford et al., as applied to claims 52 and 72, in view of Daniel et al. (U.S. Patent No. 5,814,064). Claims 64-69 and 84-89 were rejected under 35 U.S.C. §103(a) as being unpatentable over Stanford et al., as applied to claims 52 and 72, in view of Mazzocchi et al. (U.S. Patent No. 6,605,1024). Applicants respectfully traverse the rejections.

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP 2143.03).

For at least the reasons set forth above, Stanford et al. do not appear to teach all of the elements of independent claims 52 and 72. Neither Daniel et al. nor Mazzocchi et al. appear to remedy the shortcomings of Stanford et al. with respect to claims 52 and 72. Therefore, claims 52 and 72 are believed to be patentable over the cited combination.

Since claims 56, 64-69, 76, and 84-89 depend therefrom and add additional elements thereto, these claims are also believed to be patentable over the cited combination.

Additionally, Stanford et al. is unavailable as prior art under §103. Stanford et al., which has a filing date of February 20, 2001 and an issue and publication date of January 11, 2005 is available as prior art to the current application under 35 U.S.C. §102(e). However, 35 U.S.C. §103(c) applies in this instance to remove the reference as prior art against the current application under 35 U.S.C. §103(a). See MPEP 2136.01. Both Stanford et al. and the current application were subject to an obligation of assignment to the same person at the time the invention was made.

The Stanford et al. assignment to SciMed Life Systems, Inc. can be found at Reel 011694, Frame 0074 and Reel 012988, Frame 0012, with a name change to Boston Scientific SciMed, Inc. recorded on Reel 018505, Frame 0868. The assignment of the current application to SciMed Life Systems, Inc. can be found at Reel 012911, Frame 0375, with a name change to Boston Scientific SciMed, Inc. recorded on Reel 018505, Frame 0868. Therefore, Stanford et al. is disqualified as prior art in formulating the obviousness rejection under the provisions of 35 U.S.C. §103(c).

In the absence of Stanford et al., Daniel et al. and Mazzocchi et al. appear incapable of rendering the claims obvious, as they do not appear to teach or suggest all of the elements of the claims, as is required to establish a *prima facie* rejection.

For at least the reasons discussed above, Applicants respectfully request that the rejections be withdrawn.

Conclusion

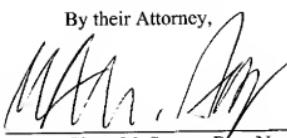
In view of the foregoing, all pending claims are believed to be in condition for allowance. Further examination, reconsideration, and withdrawal of the rejections are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their Attorney,

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